



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,609	12/26/2000	Gerald R. Stanley	CRI0033.1	4249

7590 12/23/2002

SANDERS N. HILLIS, ESQ.
BRINKS HOFER GILSON & LIONE
ONE INDIANA SQUARE
SUITE 2425
INDIANAPOLIS, IN 46204

EXAMINER

CUNNINGHAM, TERRY D

ART UNIT	PAPER NUMBER
----------	--------------

2816

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,609

Applicant(s)

STANLEY, GERALD R.

Examiner

Terry D. Cunningham

Art Unit

2816

-- **Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 9-21 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

New Matter

The amendment filed 18 November 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the amendment to page 10 and new Fig. 6.

Applicant points to page 3 of the specification for support for the new disclosure on page 10 and new Fig. 6. However, Examiner contends that one skilled in the art would not interpret the disclosure in new Fig. 6 to be enabled by page 3. Page 3, lines 9-17, discuss a circuit having “an input terminal”, “an output terminal”, “a load”, “a pulse width modulation circuit”, “an error amplifier and modulator”, “a demodulation filter” and “a feedback control loop” includes “an active low-pass filter” having both “a feedback demodulation filter” and “an isolated-integrator frequency-rejecting network”. It is clear that new Fig. 6 does not include “a feedback control loop” additionally having “an isolated-integrator frequency-rejecting network” as expressly disclosed on page 3. As clearly understood from lines 9-17 of page 3 and lines 1-11 of page 10, the “isolated Examiner further contends that ones skilled in the art would interpret the discussion in lines 9-17 as reading on and only on the circuit shown in Fig. 5. And lastly, Examiner contends that the specification does not, in any way, enable one skilled in the art as how to make any/or the invention of Fig. 6.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to because Fig. 6 is inconsistent with the disclosure therefor. The new disclosure for Fig. 6 expressly states that the “low-pass filter” has “a feedback

Art Unit: 2816

demodulation filter” and an isolated integrator frequency-rejecting network”. However, nowhere is the circuit of Fig. 6 seen to include the “isolated-integrator band-reject filter”.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-10 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. The connection between the output of the "demodulation filter" and the "feedback control loop" is deemed critical or essential to the practice of the invention, but is not included in the claim(s). An arrangement lacking this feature is not enabled by the disclosure since it cannot be understood from the specification how the circuit will operate without such. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Examiner has fully considered Applicant's remarks for the above rejection and has not found them to be persuasive. Further, these remarks and the proposed charges are not understood. As expressly discussed above, nowhere in the specification (particularly the cited portions by Applicant) is it seen to enable a circuit lacking “filter” 46 of Fig. 5. Thus, the new submission cannot be seen to overcome the rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2816

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, it is not understood how the circuit can operate without the above discussed “critical feature”.

Claim 10 is rejected for the reasons discussed above with claim 9.

Claim 19 is rejected for similar reasons as claim 3.

Examiner has fully considered Applicant’s remarks for the above rejection and has not found them to be persuasive for the reasons as discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 13-18, 20 and 21 are rejected under 35 U.S.C. §102(b) as being anticipated by Cavigelli (USPN 5,635,871). Cavigelli discloses, in Figs. 1 and 12a, a circuit comprising: “a low-pass filter circuit (all of Fig. 1 and 12a)”; and “an isolated-integrator band-reject filter (202 of Fig. 12a)”, all connected and operating similarly as recited by Applicant.

Examiner has fully considered Applicant’s remarks for the above rejection and has not found them to be persuasive. Applicant has provided numerous references apparently in attempt to show that 202 of Cavigelli is not an “isolated-integrator band-reject filter”, however, nowhere

Art Unit: 2816

does Applicant clarify the relevance of these references. The only understood relevance is that such establishes the well known fact that “notch” and “band-reject” are synonymous terms for filters. Thus, this establishes that notch filter 202 is a “band-reject” filter. Further, Applicant argues concerning the language “isolated-integrator”. However, it is not seen that the specification has provided a specific definition for this terminology nor is it seen that the term has well known meaning in the art with respect to “band-reject” filters. Thus, one must interpret such using broadest reasonable interpretation. Examiner contends that “band-reject” filters inherent provide integration and include isolation. Thus, using broadest reasonable interpretation, it would be reasonable to consider the “band reject” filter of Cavigelli as being “isolated-integrator”.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 6 is deemed allowable because none of the circuit prior art references are seen to disclose the specific arrangement with the specific connections and elements recited for the “feedback control loop”.

Due to the present lack of definiteness and/or enablement in claims 9-12 and 19, allowable subject matter cannot be determined.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2816


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terry Cunningham whose telephone number is 703-308-4872. The examiner can normally be reached on Monday-Thursday from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy P. Callahan can be reached on 703-308-4876. The fax phone numbers for Technology Center 2800 are 703-872-9318 for Before Final communications and 703-872-9319 for After Final communications. Please note, any faxed paper clearly stating **DRAFT** or **PROPOSED AMENDMENT** at the top will be forwarded directly to the Examiner. All others will be treated as a formal response and acted upon accordingly.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 703-308-0956.

TC
December 19, 2002


Terry D. Cunningham
Primary Examiner
Art Unit 2816